



GAV 3763

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Total Number Of Pages In This Submission

4

Application Number

09/097,023

Filing Date

June 12, 1998

First Named Inventor

Jill McFADDEN

Group Art Unit

3763

Examiner Name

M. Thompson

Attorney Docket No.

290252021800

ENCLOSURES (check all that apply)

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(for an Application) | <input type="checkbox"/> After Allowance Communication to Group |
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Morrison & Foerster LLP, 755 Page Mill Road, Palo Alto, California 94304-1018

or

Individual Name

Johney U. Han (Registration No. 45,565)

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Date

February 13, 2001

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Laura Shires

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Laura Shires
Laura Shires

M. Thompson
Chapman
22807

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

Jill MCFADDEN et al.

Serial No.: 09/097,023

Filing Date: June 12, 1998

For: CATHETER WITH KNIT SECTION



Examiner: M. Thompson

Group Art Unit: 3763

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RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This is in response to the Restriction Requirement dated January 18, 2001 (Paper No. 16) for which a response was due on February 17, 2001. Accordingly, this response is timely filed.

Applicants hereby elect Group I (claims 1-15, 17-22, 24-30, and 54-57) with traverse. Applicants expressly reserve the right under 35 U.S.C. § 121 to file a divisional application directed to the non-elected subject matter during the pendency of this application, or an application claiming priority from this application.

Applicants respectfully traverse this Restriction Requirement on the grounds that it does not satisfy the prerequisites of M.P.E.P. § 816. Relative to a combination and a subcombination thereof, the Examiner must show that the combination as claimed does not require the

subcombination and that the subcombination is usable alone or in another combination. Under p.2, ¶2, of the Restriction Requirement (Paper no. 16), the Examiner states that:

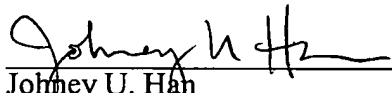
the combination as claimed does not require the particulars of the subcombination as claimed because, for example, in both independent claims 1 and 24 of the subcombination require the tubular member defining a lumen specifically requiring the tubular member to have a hollow lumen as opposed to a solid tubular member.

Applicants would draw the Examiner's attention to the claim language in Group II (claims 31-42, 44-48, 50-53, and 58-60) where independent claim 31 recites a catheter having a segment comprising the subcombination of the catheter section of Group I. The Examiner has not shown that the combination as claimed does not require the subcombination merely by pointing out that claims 1 and 24 specify a hollow lumen as opposed to a solid tubular member. A catheter must have a lumen to be operable. Therefore, Applicants must disagree with the Examiner's assertion and further contend that it would not be a serious burden on the Examiner to examine both Groups I and II. Said another way, it appears that each combination requires the details of the subcombination. Accordingly, Applicants respectfully request the withdrawal of the Restriction Requirement.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 290252021800. However, the Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

Dated: February 13, 2001

By: 
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Registration No. 45,565

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